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filed October 27, 1999, and entitled "Multi-Tier Data Storage System," which is incorporated by reference.

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**REMARKS**

5           In the office action dated 9/11/03, claims 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-  
92, 107-115 and 132 were rejected under Section 103(a) as unpatentable over Fredlund  
(5,666,215) and Johnson (6,052,670). Claims 9-11 and 88-90 were rejected under Section  
103(a) as unpatentable over Fredlund, Johnson, and Shiota (6,324,521). Claims 14 and 93  
were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Tackbary  
10          (5,555,496). Claims 15-25, 27-28, 94-102 and 104-105 were rejected under Section 103(a) as  
unpatentable over Fredlund, Johnson and Cok (6,157,436). Claims 26 and 103 were rejected  
under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota. Claim 29 was  
rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Clark  
15          (4,854,094). Claim 43 was rejected under Section 103(a) as unpatentable over Fredlund,  
Johnson and Stancato (5,056,823). Claims 49-51 were rejected under Section 103(a) as  
unpatentable over Fredlund, Johnson and Tackbary. Claims 52-53 were rejected under  
Section 103(a) as unpatentable over Fredlund, Johnson and Brewen (4,872,706). Claims 54-  
56 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Stancato.  
Claims 59-61, 71-75 and 77-78 were rejected under Section 103(a) as unpatentable over  
20          Fredlund, Johnson and Cok. Claim 62 were rejected under Section 103(a) as unpatentable  
over Fredlund, Johnson, Cok and Klees (5,652,936). Claims 63-65 and 69 were rejected  
under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Claims 66-68 and 76  
were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota.  
Claim 70 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok  
25          and Tackbary. Claim 79 and 106 was rejected under Section 103(a) as unpatentable over  
Fredlund, Johnson, Cok and Clark. Claims 116-119 were rejected under Section 103(a) as  
unpatentable over Fredlund, Johnson and Shiota. Claim 120 was rejected under Section  
103(a) as unpatentable over Fredlund, Johnson, Shiota and Clark. Claims 121-126 were  
rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Shiota and Cok.  
Claims 127, 130 and 131 were rejected under Section 103(a) as unpatentable over Fredlund,  
30          Klees and Shiota. Claims 128-129 were rejected under Section 103(a) as unpatentable over  
Fredlund, Klees, Shiota and Ohtsuka (EPO 98118497.1). Claims 133-146 were rejected

under Section 103(a) as unpatentable over Fredlund and Cok. Claims 147-153 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Finally, claims 154-155 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota.

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#### THE INFORMALITY OBJECTION

The Office Action noted the patent application number is missing on page 13. The information has been provided. Withdrawal of the Objection is requested.

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#### THE SECTION 103 REJECTION

All claims were rejected under Section 103(a) as unpatentable over at least Fredlund (5,666,215) and Johnson (6,052,670). As discussed below, Applicants traverse the rejections and respectfully submit that all claims are in condition for allowance.

Fredlund shows a system where a photographic image can be viewed at a customer's location on her personal computer and images selected for initial printing, reprinting and ordering related image services. The Office Action noted that "[t]he difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that 'each order may have multiple ship addresses and multiple order items'. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient."

Applicant notes that the present rejection does not establish prima facie obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support prima facie obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish prima facie obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01;

*In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991).

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Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

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Applicant traverses the comparison. Here, Johnson shows an object oriented framework mechanism for an electronic catalog. The electronic catalog framework includes core classes and extensible classes that allow a framework consumer to implement a desired electronic catalog. As discussed on Col. 17, lines 16-49, the electronic catalog allows users to select from a common list of products to all customers.

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Referring to FIG. 9, an example of electronic catalog framework 870 (FIG. 8) in accordance with the preferred embodiment performs steps that comprise a method 900 for defining an electronic catalog. The first step is to setup the components that are needed to define and use the desired electronic catalog (step 910). This step builds and maintains critical objects in the electronic catalog, such as product objects, the catalog object, order objects, and customer objects. Once one or more catalogs are defined and ready to use, a customer may interact with the electronic catalog to browse for product information and to place an order. To start using an electronic catalog, a user typically selects the desired catalog (step 920). For an on-line catalog, this selection may be made by the user clicking a link that identifies which catalog to use. Next, the customer may enter information that identifies the customer to the electronic catalog (step 930). This information may include a user password or authorization code if use of the catalog is restricted to authorized users. The electronic catalog then validates the customer information, if required (step 940). If the customer is authorized to access the electronic catalog, the catalog cover is then displayed to the user (step 950). The cover page may include advertisements for special sales items, or any other appropriate information that needs to be conveyed to a user. The cover page will typically include a link that will open the catalog (step 960) when selected by a user. Once the catalog has been opened, the catalog may process any user request that is supported by the catalog (step 970). Examples of some suitable user requests are: finding a product; jumping to a catalog index; jumping to a listing of the contents of the catalog; jumping to a table of contents; and creating a pick list. Once the pick list is complete, the user may submit the pick list to create an order (step 980).

However, this shopping modality is different than that for photo printing, where each image is unique. Each user uploads images in his or her account. The images in each user's account are completely personalized to the user. An electronic catalog that can be viewed and selected by all users does not simply exist in photo printing in the instant application.

5 Applying Johnson's teaching to Fredlund would not have resulted in an operable system since there is no common list of products/services such as those found in a catalog. *Argy*

10 A catalog is geared to selling standardized products that can be catalogued. In contrast, in the photography field, each image product is unique and individualized. The concept of a catalog selling custom/individualized images in single quantity is inapposite. Hence, Fredlund does not allow a user to order for multiple recipients at different addresses in one order wherein each recipient can receive different photo products in such an order. Similarly, Johnson's electronic catalog does not describe such method of submitting one order having different recipients wherein each recipient receives different products. One skilled in the art would not have combined a catalog system such as Johnson with the 15 Fredlund catalog to provide uniquely individualized photo products as in the claimed invention.

The combination suggested in the office action was done using selective hindsight. There is no suggestion or motivation in Johnson to modify Fredlund to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an 20 order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient. *Argy*

25 Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the 30 reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its *Argy*)

understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

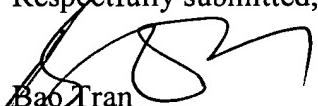
5 Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claims (and dependent claims) be withdrawn and the claims be allowed.

10 The dependent claims overcome the Section 103 rejection because they depend from allowable independent claims. Further, Applicants note that the MPEP Section 2143.01 - Suggestion or Motivation To Modify the References – has pronounced that a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some 15 objective reason to combine the teachings of the references.

#### CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

20 If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,  
  
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